

REMARKS

Initially, Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority and for acknowledging receipt of the certified copy of the priority document.

Applicant also thanks the Examiner for considering the documents cited in the Information Disclosure Statement, filed on February 25, 2004.

Upon entry of the above amendments, claims 1-2 will have been amended and claims 3-14 will have been newly added. Further, no claims will have been canceled. Accordingly, Applicant respectfully requests reconsideration and allowance of claims 1-14, which are currently pending, together with withdrawal of the outstanding rejections. The amendments to the claims merely provide clarity, but do not narrow the scope thereof.

In the Official Action, the Examiner rejected claims 1-2 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. In particular, the Examiner asserts that the recitation of at least one groove being formed in a longitudinal direction is inaccurate since the Examiner believes that the direction of the at least one groove is circumferential and not longitudinal.

Applicant respectfully notes that the at least one groove extends circumferentially, as indicated by the Examiner. However, Applicant respectfully submits that the at least one groove is also positioned along the longitudinal direction of the insert-nut. Further, if the at least one groove comprises plural grooves they are longitudinally spaced. For example, Figure 3 depicts two grooves, which are longitudinally spaced at regular intervals along the insert nut. Nevertheless, in order to expedite prosecution and to overcome the rejection under 35 U.S.C. § 112, second paragraph, Applicant has amended the claims to clarify that the at least one groove extends circumferentially with respect to the insert-nut and that the at least one groove is also longitudinally positioned along the insert-nut. Thus, as the rejection is believed to be overcome by clarifying both the formation and the spacing of the at least one groove, withdrawal of the rejection and favorable reconsideration is respectfully requested.

In addition, the Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by QUANEY (United States Patent No. 4,059,199). Further, claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over QUANEY.

Applicant respectfully traverses each of the above rejections and respectfully submits that they are inappropriate with respect to the claims pending in the present application. More specifically, the present invention, as disclosed by the Applicant, is directed towards, inter alia, an insert-nut having a polygonal shape and having at least one circumferentially extending groove spaced along the longitudinal direction of the

insert-nut. Thus, in accordance with the objectives of the present invention, such configuration advantageously allows for plastic to be easily injected into a plurality of gaps provided between the insert-nut and a surface of an insert-hole. Accordingly, joint strength and rotation resistance power are improved.

However, Applicant respectfully submits that QUANEY fails to disclose or suggest each and every feature as recited in the claims. For example, QUANEY fails to disclose or suggest, *inter alia*, an insert-nut having a plurality of sidewalls, which are configured to provide a plurality of gaps with respect to a surface of an installation hole, as recited in the claims. In direct contrast, QUANEY discloses a threaded fastener of a unitary metal machined part embedded in plastic material that completely fills the space between the flange shoulders (46, 48) and tightly engages the peripheral surfaces of the central shank and the two flanges to firmly hold the fastener in place (e.g., Column 2, lines 45-48). As QUANEY is directed towards having plastic material completely filling the space and tightly engaging the peripheral surfaces, QUANEY does not teach or render obvious the claimed feature of sidewalls configured to provide a plurality of gaps between the sidewalls of the insert-nut and a surface of an installation hole. Since QUANEY fails to teach at least this feature, Applicant respectfully requests withdrawal of the rejection and passage of the present application to issue.

Furthermore, Applicant respectfully submits new claims 3-14 for the Examiner's consideration. Claims 3 and 9 recite, *inter alia*, that the polygonal shape is a pentagon.

Support for claims 3 and 9 can be found, for example, in Figure 5 or on page 5 of the specification. Claims 4 and 11 are directed towards, inter alia, a length of the insert-nut as corresponding to a thickness of the carrier. The features recited in claims 4 and 11 are supported by page 5 of the specification. Claims 5 and 12 are directed towards, inter alia, the at least one groove being circular. Claims 6 and 13 are directed towards, inter alia, the at least one groove being pentagonal shaped. Support for claims 5-6 and 12-13 can be found, for example, on page 7 of the specification. Claims 7 and 14 are directed towards, inter alia, a plurality of grooves spaced along the longitudinal dimension of the insert-nut. Claim 10 recites, inter alia, that the polygonal shape is a hexagon, which is supported by, for example, Figure 3 of the specification.

Furthermore, claim 8 is directed towards a method for securing an insert-nut to an insert-hole. Independent claim 8 is believed to be allowable for at least reciting that a plurality of gaps are provided between the insert-nut and the insert hole. As discussed above, QUANEY fails to disclose or suggest at least this feature. Thus, Applicant respectfully submits that claim 8 is believed to be allowable for at least this feature in combination with the other features recited in claim 8.

Accordingly, new claims 4-7 and 9-14 are believed to be allowable for at least the features mentioned above, as well as for depending on either independent claim 1 or independent claim 8, which Applicant has shown to be allowable. Therefore, Applicant respectfully requests reconsideration and withdrawal of each of the outstanding rejections

together with an indication of the allowability of all of the claims in the present application, in due course.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the references cited by the Examiner, and an indication to such effect is respectfully requested, in due course. Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections of the claims, as well as an indication of the allowability of each of the claims in view of the herein-contained remarks.

SUMMARY AND CONCLUSION

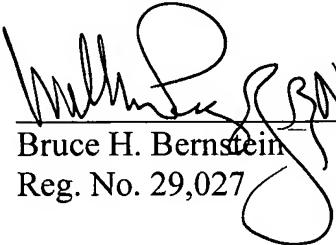
Applicants believe that the present application is in condition for allowance, and respectfully request an indication to that effect. Applicants have amended the claims to enhance clarity and provided explicit evidence of their allowability. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the recited claims therein are respectfully requested and now believed to be appropriate.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Eiichi ISHIGAKI et al.


Bruce H. Bernstein
Reg. No. 29,027

July 13, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191